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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,735	07/03/2001	Michael J. Gazewood	115.015	5587

7590 04/10/2003

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EXAMINER

HEWITT, JAMES M

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 04/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/898,735	GAZEWOOD, MICHAEL J.	
	Examiner	Art Unit	
	James M Hewitt	3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-51 is/are pending in the application.
- 4a) Of the above claim(s) 29-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-28 and 34-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: the title of the invention should be provided on the first line of the first page of the specification.

Appropriate correction is required.

Drawings

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 12/2/02 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Terminal Disclaimer

The terminal disclaimer filed 12/2/02 has been received .

Claim Objections

Claims 21-24, 34-35, 44 are objected to because of the following informalities:

In claim 21 line 7, "top swage" should be "first cylindrical anchoring member".

In claim 24 line 9, "bottom swage member" should be "second cylindrical anchoring member".

In claim 34 line 6, "fist" should be "first".

In claim 34 line 8, "top swage member" should be "first cylindrical sleeve".

In claim 35 line 7, "bottom swage member" should be "second cylindrical sleeve".

In claim 44 line 3, "and" should be "an".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-24, 27-28, 34-38, 40-44, 46, 48-51 are rejected under 35

U.S.C. 102(b) as being anticipated by Owen et al (US 3,948,321)..

With respect to claim 21, Owen et al discloses an anchoring apparatus for use in a tubular member, the apparatus comprising: a top swage member (27); a first cylindrical anchoring member/sleeve (31) disposed about the top swage member, said anchoring member containing a first plurality of expandable circumferential ribs (see Figures 4A and 6), the ribs are configured to form a substantially metal-to-metal seal with the tubular member (see Figure 6 and col. 4 lines 17-21); setting means (11) for driving said top swage member into said anchoring member so that said ribs are expanded outward, an extension member (39) having a first end attached to said first cylindrical anchoring member (see col. 5 lines 21-28).

With respect to claim 22, wherein the first ribs at least partially grip and embed in the tubular member when forming the metal-to-metal seal.

With respect to claim 23, wherein said first anchoring member further comprises an elastomeric seal (49) set apart from said first ribs. Refer to Figure 4A and 6, wherein the seal (49) is within a recess or cavity below the first ribs.

With respect to claim 24, further comprising a second cylindrical anchoring member/sleeve (33) having the same construction as the first (31); a bottom swage member (29); wherein said setting tool (11) is further adapted for driving said bottom swage into said second anchoring member and radially deforming said second anchoring member so that said second ribs are expanded outward.

With respect to claim 27, wherein said extension member includes a bridge plug device.

With respect to claim 28, wherein said bottom swage has a first cylindrical surface that extends to a second conical surface, wherein said first surface is concentrically disposed within said second anchoring member.

With respect to claims 34-37, refer to the above rejections and Figure 4B.

With respect to claims, 38, 40-44, 46, 48 and 49, also refer to the above rejections.

With respect to claim 47, the first group of rib elements is on the first anchoring member, the second group is on the second anchoring member. Elastomer (49) is disposed therebetween.

With respect to claim 50, wherein said downhole tool is selected from a group consisting of a tubing patch, a casing patch, a gravel pack assembly and a bridge plug.

With respect to claim 51, wherein the setting tool is one of hydraulically actuated and explosively actuated.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25-26, 39 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owen et al (US 3,948,321).

Owen et al fails to teach the hardness of the anchoring members, yet states that the members are sufficiently malleable and are adapted to be expanded. Further in another patent to Owen et al, US 3,746,091, the material is said to be a low carbon. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ anchoring members with a hardness of 105 or less on the Rockwell B scale since low carbon, malleable steel is consistent with such a hardness and it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

The Examiner takes Official Notice of the use of Teflon to coat an anchoring member in a well bore in order to increase the strength of the member.

Owen discloses a first set of elastomer-free ribs. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a second set since it has been held that a mere duplication of the essential working parts only involves routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Response to Arguments

Applicant's arguments filed 1-3-03 have been fully considered but they are not persuasive. As discussed with Applicant's representative, the Examiner has taken the position that from the Figures, especially 4A and 6, the rib elements do not necessarily include seals therein. In Figure 5, the bottommost groove is shown to include a seal, whereas Figures 4A and 6 show a cavity or recess disposed below the set of ribs for holding an elastomeric seal (49). It is the Examiner's position that Owen et al discloses a plurality of ribs on each of his anchoring members which make a metal-to-metal seal with the tubular member. An elastomeric seal is effected by seal (49) at a position below the set of ribs, or in a bottom groove between two lower ribs.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M Hewitt whose telephone number is 703-305-0552. The examiner can normally be reached on M-F, 930am-600pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on 703-308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

jmh
April 4, 2003


Lynne H. Browne
Supervisory Patent Examiner
Technology Center 3620